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Remarks35 USC § 112 Rejections**A. The Examiner wrote:**

Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not understood how one or more grooves are opened at one or more ends of the grooves with respect to figures 5-6.

Claim 10 is fully supported in the specification. Paragraph 19 reads:

Each groove may be opened or closed at its ends (2b). If the groove has a closed end, then the closed end of the groove inhibits the extruded powder from sliding out of the groove (see figure 2). If the groove has an opened end, then the extruded powder may slide into or out of the groove (see figure 1).

The specification specifically directs the reader to figure 1 to see a representation of an open ended groove. Why the office action looks only to figures 5 and 6 for this feature is unclear to the applicant. At any rate, figure 1 serves to graphically depict the features of claim 10. Therefore, reconsideration is requested.

**B. The Examiner wrote:**

Claims 6-8, 10-11, 13-14, 16-17 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite...

Claims 6-8, 10-11, 13-14, 16-17 and 29 recite the limitation "the grooves, the extruded powders and the groove openings" in claims 6-8, 10-11, 13-14, 16-17 and 29. There is insufficient antecedent basis for this limitation in the claim.

A finding of lack of antecedent basis may only be found if the lack of antecedent basis renders a claim indefinite. The Examiner has not explained why anyone reading those claims would find them indefinite. Nevertheless, the applicant has complied with what he believes are the Examiner's concerns. Claims 1, 2, 6-8, 13, 14 and 29 have been amended such that the number of grooves, powders and openings being recited are consistent throughout the claims.

C. The abstract has been amended as the Examiner pointed out, replacing "the" with "The".

35 USC § 102 Rejection

Claims 1-2, 6-7, 11-12, 15, 17-19 and 26-28 are rejected under 35 USC 102(b) over Israel (US 4,887,409). The Examiner wrote:

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With regard to claims 1-2, Israel et al discloses a case (figs. 1-2) comprising a surface (28) having a groove (recess 26), at least one cosmetic powder (40) disposing in the groove. The method used to form the powders by extruding is given no patentable weight.

It is odd that the Examiner should say that the method of extruding is given no patentable weight, because no method steps have been recited in the claim. Applicant assumes the Examiner means that the recitation of the extruded powder itself is given no patentable weight. This, however, is a serious mistake that completely misses the point of the present invention. The applicant took some pains in the specification to explain the differences between extruded powders and pressed powders. They are generally different in composition and each has advantages and disadvantages over the other, depending on the situation. In terms of composition, pressed powders are formulated with comparatively little aqueous binder. This is possible because pressed powders are supported in a pan and receive a high degree of compaction. In contrast, extruded powders do not have the degree of compaction and are not supported in a receptacle. Therefore, extruded powders require a substantial aqueous binder phase to hold the end product together. Also, pressed powder material is pulverized prior to filling and pressing. This places limitations on the composition of the pressed powder because the formulator is excluded from including any materials that would be ruined by the pulverizing process. For example, pearl pigments are unsuitable for pressed powder formulations. In contrast, an extruded powder is not pulverized before extrusion and therefore may contain a wider variety of relatively large materials, such as pearl.

A discussion of advantages and disadvantages of the claimed invention over the prior art is usually more appropriate for 35 USC 103 rejections. However, such a discussion is appropriate when demonstrating "patentable weight". Therefore, applicant will reiterate some of the advantages and disadvantages between extruded and pressed powders. For example, paragraph 6, lines 3-17 of the specification read:

Extruded powder sticks offer an alternative to pressed powders, having advantages in handling and filling. One disadvantage arises because the sticks are generally used by directly drawing the stick over the skin. To this end, the sticks must be formulated to meet conflicting requirements, i.e., possess cohesive strength sufficient to prevent breakage when being drawn over the skin, while being soft enough to yield adequate "pay-off". Pay-off refers to the stick's ability to deposit product as it is drawn over a surface, i.e., the skin. These conflicting requirements place limitations on the chemical composition of the product. Because of their intended method of use, extruded stick powders are not typically applied with a brush and different colors are not typically mixed

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prior to application. In contrast, the powder case of the present invention, for the first time, permits the use of a brush applicator to mix and apply multiple colors of extruded stick powders. Furthermore, because the sticks are well supported by the case and do not directly contact the skin, they do not have to be formulated to resist breakage to the same degree as the sticks described above. This makes it easier to formulate the sticks to have adequate payoff. Therefore, the present powder case offers more flexibility in the chemical composition of the powder product itself.

The fact that claim 1 exploits conventionally recognized differences between extruded and pressed powders to solve art recognized problems, is probative of patentable distinction in claim 1. Although the above excerpt from the specification should suffice, applicant will elaborate on how claim 1 exploits the differences between extruded and pressed powders.

1. Placing extruded powders in a case as described in claim 1 has overcome the disadvantage that extruded powders must be formulated to resist breakage when drawn across the skin. This is because the extruded powder in claim 1 is supported by the case and applied with a brush. To the best of the applicant's knowledge this has never been done with extruded powders. As a result, the extruded powders of claim 1 no longer need to be formulated to resist breakage to the same degree as conventionally used extruded powders. This is a real advantage because the number of possibilities of what the formulation may be is increased. Therefore, a conventional limitation of extruded powders is removed by the invention of claim 1.

2. One disadvantage of pressed powders is that it is conventionally all but impossible to package a large number of pressed powders in close proximity to one another in a conveniently sized case. This is because of the size requirements of pans of pressed powder. Usually, not more than four or six powders are seen together in a cosmetic compact. In contrast, extruded powders can be manufactured to take up significantly less area in a compact case thus allowing many more extruded powders than pressed powders to be included. Therefore, it is the use of extruded powders in a novel way that has solved the art recognized problem of not being able to provide a large number of pressed powders in close proximity to one another in a conveniently sized case.

3. The invention of claim 1 has provided a cosmetic compact capable of achieving multicolor, ombre cosmetic effects not before achieved in so convenient a case. This

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ombre effect is not achievable with pressed powders because of the limited numbers of pressed powders that can be put in one compact case. Beyond providing many more colors in one case, the present invention enables multicolor, ombre cosmetic effects by using an applicator brush to mix and apply the extruded powders. To the best of the applicant's knowledge this has never been done with extruded powders and doing so overcomes a limitation of pressed powder compacts.

4. The placement of extruded powders in a compact case that is usually reserved for pressed powders has certain manufacturing advantages. Pressed powders are made by filling loose powder into a pan and then pressing to give the powder firmness. The pan is then loaded into a compact case. Once pressed, the powder must remain in the pan because to remove the pressed powder from the pan would destroy its compaction. This limits degree to which the powder can be handled and further processed after it has been pressed. In contrast, extruded powders are self-supporting (see specification paragraph 18, line 6). This allows the powder to be handled or further processed before being filled into a final compact case. Also, there is no need for an intermediate container, i.e. a pan, so the cost of the compact is reduced.

Based on the foregoing, it should be clear that claim 1 exploits differences between extruded and pressed powders to solve art recognized problems. Therefore, the recitation of extruded powders in claim 1 is probative of patentable distinction and must be given patentable weight. Applicant respectfully asks the Examiner to reverse her finding of no patentable weight.

Assuming the point is made, claim 1 is not anticipated by Israel, because Israel does not recite all of the elements of original or currently amended claim 1.

To constitute an anticipation, a reference must contain **each and every element** of the rejected claim within its teachings; absence of a claim element from a prior art reference **negates** anticipation. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 224 USPQ 409 (Fed. Cir. 1984).

It is well established that a rejection for anticipation under section 102 requires that **each and every** limitation of the claimed invention be disclosed in a single prior art reference. *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994).

Israel makes no mention of an extruded powder, let alone an extruded powder disposed in a groove. Israel at great length describes the flowable powders being loaded into a pan and subsequently pressed to give the powder firmness. But, as

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discussed, pressed powders are not the same as extruded powders. Based on the absence of extruded powders in Israel, Israel does not anticipate the present invention. Applicant requests reconsideration of this rejection. Since claim 1 is not anticipated by Israel, neither are dependent claims 2-28. However, regarding claim 27, applicant wishes to point out that Israel does not disclose a cover which is friction fit onto the surface. The cover 14 in Israel is secured by a fastener made up of detent 18 and slot 20. For this reason, claim 27 is further not anticipated by Israel.

### **35 USC § 103 Rejections**

**A.** Claims 3-5 stand rejected as being unpatentable over Israel in view of von Kleinsorgen. The Examiner wrote:

With regard to claims 3-5, Israel et al discloses a case comprising all the claimed limitations in claim 1 as discussed above except for the powders being not all the same color and chemical composition...Von Kleinsorgen discloses a cosmetic stick (fig. 1) comprising at least two powders (12, 13) being not all the same color and chemical composition (col. 4, lines 19-22)...It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the particular powder as taught by von Kleinsorgen into the case of Israel for the purpose of providing a plurality of different colors."

There are a number of flaws in the Examiner's statement. Firstly, Israel certainly does disclose powders of different colors (col. 1, lines 20-21; col. 2, line 8, col. 3, lines 54-55, col. 5, line 66 - col. 6, line 1) and/or different chemical compositions (col. 6, lines 1-4). There is really no need to use von Kleinsorgen to introduce the concept of multiple colors or chemical compositions. This, however, proves to be irrelevant because the Examiner's initial statement, that Israel discloses the limitations of claim 1, has already been shown to be false, there being no extruded powders in Israel. Obviously then, even though von Kleinsorgen discloses multicolored powders and powders of different chemical compositions, claims 3-5 are still not rendered obvious. Notwithstanding the above, von Kleinsorgen does disclose "powder sticks" and applicant wishes to make some remarks about the combination of Israel in view of von Kleinsorgen.

### **The combination does not teach all elements of claims 3-5**

Firstly, the powder sticks of von Kleinsorgen are nowhere disclosed to be extruded powders and, as already noted, extruded powders are not disclosed in Israel.

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Therefore, the combination of Israel in view of von Kleinsorgen does not teach or suggest the extruded powders recited in claims 3-5. This alone negates the finding of obviousness, but other reasons exist as well.

The combination lacks motivation to combine or modify

The Examiner has not explained what the motivation would be to modify Israel with the teachings of von Kleinsorgen. In fact no such motivation exists. This is clear when the references are viewed **in their entirety** as it is the Examiner's responsibility to do. Why, after reading von Kleinsorgen, would a person of ordinary skill in the art replace the pressed powders of Israel with the powder sticks of von Kleinsorgen? The Examiner has not placed on the record any reasoned explanation. Furthermore, the references do not teach or suggest any advantage to combining Israel and von Kleinsorgen. Actually, when read for all they disclose, the references teach away from their being combined. The Israel reference itself teaches that his invention is suitable only for compressed powders:

The articles contemplated by the present invention generally are sold to consumers in small portable containers commonly referred to as "compacts" in which the cosmetic article is stored as a **compressed powder** prior to application to the surface of the skin. The cosmetic article may comprise ... any other known cosmetic material **susceptible of being formed and stored in compressed powder mode**. Even more particularly, the cosmetic articles contemplated comprise multiple segments of cosmetic material ... reposing in individual pans..." (col. 1, lines 9-21).

In contrast, von Kleinsorgen teaches the advantages of powder sticks **over compressed powders in pans**.

...powder sticks or pencils which are used for decorative cosmetic purposes differ from the powder compacts or powder blocks insofar as a powder stick or pencil is used to apply the powder directly to the ski[n] by rubbing the actual powder pencil against the surface of the skin.... A considerable advantage of powder pencils of that kind is that the powder material can be applied to the skin in a substantially more accurate and more finely controlled manner...

Clearly, von Kleinsorgen is specifically differentiating his powder sticks from compressed powders in pans, like those of Israel. Therefore, von Kleinsorgen teaches away from Israel. This is a very strong motivation not to combine the references.

The combination lacks expectation of success

Furthermore, there is no expectation of success because the proposed combination cannot be done successfully. The Examiner wrote:

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the particular powder as taught by von Kleinsorgen into the case of Israel for the purpose of providing a plurality of different colors."

Employing "the particular powder as taught by von Kleinsorgen into the case of Israel" will not work. The essence of Israel is a process for filling and pressing loose powder in a single operation. The Examiner cannot simply ignore this portion of Israel. It is absolutely necessary for the Examiner to **consider the reference as a whole**. If you put the powder sticks of von Kleinsorgen into the filling and pressing machinery of Israel several things will happen. Firstly, the powder sticks will be destroyed so as not to be powder sticks anymore, rendering von Kleinsorgen inoperative for its intended purpose. In fact, if anything, the result will be the powder compacts and powder blocks from which von Kleinsorgen specifically differentiated his invention. Secondly, the powder sticks of von Kleinsorgen are comprised of stick portions of differing colors and chemical compositions stuck together. If such a powder stick is put into the machine of Israel, where it will be compressed and destroyed, the colors and formulae will be mashed together so that what comes out is not multiple powders of different colors and compositions but some unusable conglomerate. Also, the chemical compositions of von Kleinsorgen are suitable for powder sticks while those of Israel are suitable for compacts. A person of ordinary skill in the art will appreciate that these formulations have basic differences that make them suitable for their respective end use. Therefore, a person of ordinary skill in the art would not be expected to simply substitute the powder stick compositions of von Kleinsorgen into the compressed powder machinery of Israel.

In conclusion, when both references are read for all they disclose, it is clear that there is no meaningful way to combine Israel and von Kleinsorgen. The combination does not teach or suggest all of the elements of claims 3-5, the combination lacks motivation, as well as expectation of success. In fact, the references teach away from the combination and the office action fails to place on the record any reasoned statement in support of the combination. For these reasons, reconsideration of this rejection is respectfully requested.

**B.** Claims 8-9 and 13-14 stand rejected as being unpatentable over Israel et al in view of Schefer. The Examiner wrote:

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With regard to claims 13-14, Israel et al discloses a case comprising all the claimed limitations in claim 1 as discussed above ...

Based on the foregoing discussion, the Examiner's initial position, that claim 1, from which claims 8-9 and 13-14 depend, is anticipated by Israel is incorrect. Therefore, when the Examiner relies on Schefer to introduce the additional elements of claims 8-9 and 13-14, the combination still fails to teach or suggest recited elements of claim 1. Specifically, the combination of Israel and Schefer fails to teach an extruded powder, let alone an extruded powder disposed in a groove. Differences between extruded and pressed powders have been discussed above, particularly noting that those differences suggest not to use an extruded powder in the manner revealed in the applicant's specification. Nothing in Schefer changes that fact. Schefer does not specifically say what are the physical forms of the cosmetics contemplated and therefore does not disclose an extruded powder. However, Schefer does require the cosmetic material 40 to be located in cosmetic inserts 24 (col. 3, lines 25-26). Regarding these inserts, the only embodiment disclosed in Schefer are pans of the type usually encountered in pressed powder cosmetic compacts, which, to the applicant's knowledge, are not necessary to hold extruded powders. Therefore, it must be understood that Schefer in no way contemplates doing what the applicant has done, i.e. disposing extruded powder in a groove. Since neither Israel nor Schefer alone or in combination discloses all the elements of claim 1, from which claims 8-9 and 13-14 depend, this rejection must be withdrawn.

Furthermore, claim 8 requires a portion of the powders to rise above the surface. On this point the Examiner has written:

Schefer discloses a cosmetic compact case (fig. 6) comprising a surface (30) having a plurality of grooves, a portion of cosmetic powder (24) rises above the surface (fig. 6)...

Respectfully, the Examiner is mistaken in this observation. There are two possible interpretations. If surface 30 (called "recess 30" in Schefer) is interpreted as having grooves, then ribs 36 must be included as part of surface 30 because ribs 36 are what define the grooves or "areas" 38 into which the individual cosmetic inserts 24 are received (see col. 3, lines 15-17). If this is not done, then there is no way to say that surface 30 has grooves. However, when interpreted this way, then the cosmetic material 24 of Schefer does not rise above the surface, i.e. top edge of the ribs 36.



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which is clear in figure 6. Alternatively, if surface 30 is not interpreted to include ribs 36, then surface 30 does not have grooves. Furthermore, Israel does not disclose a portion of the powders rising above the surface. Therefore, in either interpretation of Schefer, claim 8 is not rendered obvious by the combination of Israel and Schefer.

Furthermore, claim 9 requires forty percent or more of each extruded powder to rise above the surface. On this point the Examiner has written:

...it would also have been an obvious matter to one having an ordinary skill in the art at the time the invention was made to construct forty percent or more of each powder rises above the surface, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

The Examiner is misguided, here, as explained in MPEP 2144.05 II. B, entitled "Only Result-Effective Variables Can Be Optimized"

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

The degree to which the powder rises above the surface is a variable **never** before recognized in the art as being results effective. This is obvious when one considers that extruded powders have never been used in the manner that the applicant is claiming. With applicant's invention, **an applicator brush is drawn in one motion, without lifting the brush, across several extruded powders.** Neither extruded powders nor pressed powder compacts are ordinarily used in this way. With a pressed powder compact, a brush is moved over one color in the compact case and then applied to the skin. When mixing colors is desired a brush is moved over one color in the compact case, then the brush is lifted and placed on a second color in the case and then applied to the skin. Alternatively, the color mixing is done on the skin by applying the powders in succession. In either case, it is not all typical to draw the applicator across different powders in one motion, without lifting. **Because of this fact,** the powders in pressed powder compacts do not ordinarily rise above the surface in question. Generally, having the powder rise above the pan surface is not desirable because the powder is less protected and more likely to break off in the case, making a mess. Pans are typically sized so that the surface of the powder is below the top of the pan. For this reason, an ordinary person of skill in the art would not recognize the degree to which the powder rises above the surface as a results effective variable.

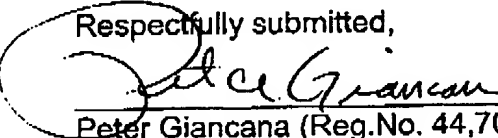
Powder above the surface is not ordinarily desired. And even if it was, that pertains to pressed powders and not to extruded powders, which have never been used in this manner before. Prior to applicant's invention a person of ordinary skill in the art would not understand the meaning of the degree to which an extruded powder rises above the surface of the case, because extruded powders were never reposed in this type of case, as the applicant has done. It must now be admitted that the degree to which the extruded powder rises above the surface is not recognized in the art as a results effective variable and therefore, a person of ordinary skill in the art could never be expected to come to the value of 40% by routine experimentation. The value of 40% is newly disclosed as a results effective amount in the applicant's disclosure. Reconsideration of the rejection of claim 9 is requested.

C. Claims 20-25 stand rejected as being unpatentable over Israel et al in view of Gueret (US 5,713,471). Once again the Examiner has erroneously relied upon the notion that Israel anticipates applicant's claim 1, from which depend claims 20-25. On that inappropriate foundation, the Examiner builds an obviousness rejection. However, since claim 1 is not anticipated by Israel, this rejection cannot stand. Furthermore, claim 1 is not rendered obvious by the combination of Israel and Gueret because neither reference discloses extruded powders let alone extruded powders disposed in grooves. Since claims 20-25 depend from a non-obvious claim, they too must be non-obvious.

Regarding all of the references cited by the Examiner, even those not relied upon but which were included to show the state of the art, the applicant wishes to point out that none of them discloses extruded powders disposed in grooves as defined in the present claims. All rejections having been addressed, allowance of all pending claims is requested.

Dated: March 12, 2003

Respectfully submitted,

  
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P&A enclosed.

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